Remarks

The Examiner has rejected claims 33-59, 61-68 and 70-84 under 35 U.S.C. §103(a) as being unpatentable over various combinations of Hashimoto, United States Patent No. 4,850,005 (hereinafter "Hashimoto"), Barber et al., United States Patent No. 5,251,251 (hereinafter "Barber"), Fisch et al., United States Patent No. 4,949,085 (hereinafter "Fisch"), Miner et al., United States Patent No. 6,021,181 (hereinafter "Miner") and Bates et al., United States Patent No. 6,741,680 (hereinafter "Bates").

Claims 33-59, 61-68 and 70-84 have been cancelled by way of the present Response. Applicant has added new claims 85-110, which include independent method claims 85 and 92, and independent apparatus claims 99 and 105. Applicant respectfully submits that the new claims are fully supported by the originally-filed disclosure and their entry is respectfully requested. Favorable consideration of the present Response as currently constituted is respectfully requested.

Rejections Under 35 U.S.C. §103(a)

In the prior office action, the Examiner rejected claims 33-59, 61-68 and 70-84 under 35 U.S.C. §103(a) as being unpatentable over various combinations of Hashimoto, Barber, Fisch, Miner and Bates. Although these claims have been canceled by way of the present response, Applicant addresses these references and the Examiner's comments related thereto in order to emphasize the

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manner in which these references fail to disclose the Applicant's invention as claimed in the prior claims as well as in the currently-pending claims.

The Hashimoto Reference:

The principal reference cited by the Examiner is the Hashimoto reference.   As noted in Applicant's prior response, Hashimoto describes a telephone answering device that utilizes artificial intelligence to determine whether the calling party has a special outgoing message. More specifically, and with reference to figure 6, Hashimoto teaches that when the calling signal is detected (step 601), a command is supplied to start the playback of the general outgoing message for the general calling party (step 603). Subsequently, if the calling party voices his name (step 605) and an affirmative recognition result is obtained via the artificial intelligence (step 606), the recognizing code indicative of coincidence in voice pattern will be read from RAM (step 609) and an associated specific message is sent out (step 612). The end of the specific message is monitored (step 613) such that when "the specific message is over, the analogue switch used until that time and the loop-forming relay Y-1 are turned off in order to release the engagment (sic) of the telephone lines (steps 613 and 614), so that the program proceeds to the step 601 where a standby condition is assumed." (Hashimoto, Column 6, lines 12-17).

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As an alternative, Hashimoto teaches that if the calling party is not recognized by the artificial intelligence (step 606), the program prompts the calling party to leave a message (step 615) and the calling party's message is recorded (step 617). When the calling party places his telephone on-hook, the Hashimoto device releases the telephone line (step 614) and returns to standby mode. Although the Examiner cites Hashimoto for a number of teachings recited in the prior set of claims. At the same time, the Examiner has conceded that Hashimoto fails to teach or suggest a number of limitations recited in the prior claims, as discussed below.

Hashimoto fails to disclose "receiving on the telephone line a code" and "playing to a calling party on the telephone line a message stored in a storage location"

The Examiner has conceded that Hashimoto fails to disclose receiving on the telephone line a code and has conceded that Hashimoto fails to disclose playing to a calling party on the telephone line a message stored in a storage location. In order to overcome these conceded deficiencies of Hashimoto, the Examiner has relied on Barber.

The Barber Reference:

The Examiner cites Barber as disclosing "receiving on the telephone line a code" and "playing on the telephone line a message stored in a storage location." Barber is directed to a telecommunications network-based greeting card method and system. A subscriber to the system selects a prerecorded message and

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records a personalized message to be played along with the prerecorded message to a recipient. As such, Barber teaches a very different system than Hashimoto, and Applicant submits that it would not be obvious to combine the two references in the manner suggested by the Examiner. Further, even in combination, Barber and Hashimoto fail to teach a number of limitations recited in the pending claims. By way of example, Applicant respectfully submits that the Examiner has not identified any teaching in Barber that the subscriber can delete or in any way modify the contents of the prerecorded message, as is recited in new claims 85, 92, 99 and 105. As described in detail in Barber, the subscriber merely _associates_ his or her own message to the prerecorded message, so that both messages are played together to the recipient. (See, e.g., col. 4, lines 15-20). Further, although the cited portion of Barber discusses the recipient retrieving and hearing both the prerecorded message and the personalized message, Applicant respectfully submits that the Examiner has not identified any teaching in Barber that the recipient can record his or her own message or delete or in any way modify any portion of the prior message at his or her option, as is also recited in the pending independent claims.

The "Replacing," "deleting" and "appending" limitations:

The previously-submitted claims recited the limitation of "_replacing_ the message stored in the storage location with the incoming message from the calling party." In the presently-pending

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claims, this limitation has been supplanted with a "deleting" step in combination with "appending at least a portion of the first incoming message to the message thread stored in the storage location corresponding to the code received from the first calling party over the telephone line". In claims 85 and 99, each caller is provided with an option to delete a portion of a message thread, while claims 92 and 105 recite a method and apparatus in which deletion is performed as a matter of course.

The Examiner has conceded that Hashimoto fails to disclose replacing the message stored in the storage location with the incoming message from the calling party received on the telephone line. The Examiner has not asserted that the "replacing" limitation is taught by Barber. The Examiner asserts, however, that this limitation is taught by Fisch.

The Fisch Reference:

Fisch is directed to prioritization of stored messages in a digital voice paging receiver. At the outset, Applicant submits that Fisch is directed to a very different application than the invention as claimed by the pending claims. Accordingly, Applicant respectfully submits that it would not have been obvious to combine Hashimoto with Fisch. The portion cited by the Examiner teaches that "the system protects unread messages by allowing only read message [sic] to be overwritten by incoming information." (Fisch, col. 12, lines 56-60). This portion of Fisch explicitly teaches that the system identifies a storage location for incoming

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information, and a new message will not be stored over a prior unread message.

The teaching of Fisch that the system identifies a storage location for an incoming message is in marked contrast to the limitations of the pending claims, in which the storage location for an incoming message is selected by the calling party providing that incoming information. The incoming message will be stored in a storage location corresponding to the code received from the calling party. The Examiner has identified no teaching or suggestion within Fisch that a caller has any control whatsoever over the storage location for the information provided by that caller. To the contrary, Fisch teaches that the storage location for incoming information is automatically selected by the system. Accordingly, Applicant respectfully submits that Fisch does not teach "replacing the message stored in the storage location with the incoming message from the calling party," as recited in the earlier claims, nor does it teach a "deleting" step in in combination with "appending at least a portion of the first incoming message to the message thread stored in the storage location corresponding to the code received from the first calling party over the telephone line".

"Message threads"

Neither Hashimoto, nor Barber, nor Fisch suggest or disclose the generation of message threads. The Examiner has cited Miner for the teaching of message threads.

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The Miner Reference:

As discussed in Applicant's prior Response, Miner teaches a telephone answering device wherein the calling party may move down through the messages in a chain or thread by performing a "More" command. After listening to the messages or message thread, the calling party can generate an incoming message that is added to a general mail box or one or more individual mailboxes. In addition the calling party may link newer messages back to older messages for which they represent a reply thus expanding the message thread. While Miner allows the calling party to add a message to the message thread, Miner fails to disclose an apparatus or method wherein the calling party can delete a stored message and append an incoming message to the message thread. Accordingly, neither Hashimoto nor Miner can be considered to render obvious the invention of the pending claims.

Fee Statement

The total number of independent claims has been reduced. The total number of claims has been reduced. Accordingly, applicant believes no fees are due for the filing of this Response. If any fees are due or overpayment have been made, however, please charge or credit our Deposit Account No. 03-1130.

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Conclusion

In view of the forgoing, the Examiner is respectfully requested to allow pending claims 84-110, presented for consideration herein. Accordingly, a favorable action in the form of an early notice of allowance is respectfully requested. The Examiner is requested to call the undersigned for any reason that would advance the instant application to issue.

Dated this 9th day of May, 2005.

Respectfully submitted:

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